In re Appln. of Frisch et al.
Application No. 10/828,729
Response to Office Action of April 26, 2007

Remarks

At the time of the Office Action, claims 1-54 were pending. Claims 1-54 stand rejected under 35 U.S.C. § 103(a) as being obvious over U.S. Patent No. 6,971,017 to Stringer et al. (hereinafter Stringer) in view of U.S. Patent Application Publication No. 2001/0018739 to Anderson et al. (hereinafter Anderson).

The Applicants traverse the rejections of claims 1-54 and respectfully request reconsideration in view of the following remarks.

The Applicants respectfully disagree with the Office's characterization of Stringer. The Applicants submit that Stringer does not disclose, teach or suggest an electronic signature method, particularly an electronic signature method with a delegation mechanism. Rather, the Applicants understand that Stringer relates to a method of accessing documents or services stored on a document server 102 to which certain users (e.g., user A) have access rights while other users (e.g., user B) do not have registered access rights. Stringer's method makes it possible for user A to provide secure access to the documents or services to user B. Registered user A is thus given the possibility to grant certain rights to an unregistered user B. This is done by means of "URL tokens" as follows. User A communicates with user B and obtains user B's certificate information at 216 (Figure 2 of Stringer). Then, user A identifies a directory path and invokes the "create URL token" function at 208. This generates a request sent at 210 to the document server 102 which creates a new entry in the token database. The token ID generated by the document server at 212 is transmitted to user A whose device signs the URL token at 218. The signature 218 is made by means of user A's private key (Figure 3 of Stringer) and is applied to data including the token ID and user B's public key. The URL token signature is returned to the document server that stores it in the token database at 222. The URL token is also transmitted to user B at 226.

User B's access to the documents/services to which he/she was granted access rights is illustrated in Figure 4 of Stringer. User B establishes a secure session with the document server at 404, and then transmits the URL token at 406. The document server 102 checks the presence of the token in the database at 408, and checks that the token was issued by a valid registered user A at 409. This step 409 involves checking the token signature by means of user A's public key. Then, at 410, the document server 102 checks that user B's public key obtained when establishing the secure session at 404 is the same as the public key associated with the URL token. The document can then be retrieved and transmitted to user B.

In re Appln. of Frisch et al.
Application No. 10/828,729
Response to Office Action of April 26, 2007

Stringer makes no reference to signing <u>documents</u> (e.g., documents made available by the document server 102). Furthermore, the signature referred to in Stringer is applied to content including user B's public key, a token ID, a document path and certain token rights (see Figure 3 of Stringer). Moreover, the signature is carried out by user A.

The following differences are noted between the independent claims (nos. 1, 18, 26, 37 and 44) of the present application and Stringer:

1. The claims are for electronically signing documents, while the documents stored in Stringer's server 102 are not signed;

2. In the claims, the documents are signed electronically by means of a cryptographic key of the second signatory, which would be "user B" in Stringer according to the Office Action's characterization. However, in the Stringer method, user B does not sign anything;

3. The claims recite associating a delegation token with a signed document, whereas Stringer associates the "URL token" with a path to an unsigned document;

4. The claims recite generating the delegation token by a server, whereas Stringer's URL token is not generated by the document server 102, but by user A's device 106 at step 218 of figure 2; and

5. The claims recite generating the delegation token in response to a request sent by the second signatory, which would be user B in Stringer according to the Office Action's characterization. In contrast, Stringer's URL token is generated in response to invocation by user A at 208.

According to MPEP 2143.03, "To establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. In re Royka, 490 F.2d 981, 180 USPQ 580 (CCPA 1974)." Furthermore, MPEP 2143.03 states, "*All words in a claim must be considered* in judging the patentability of that claim against the prior art. In re Wilson, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970)." (emphasis added)

First, the Applicants submit that the Office has not properly considered the "first signatory" and "second signatory" language in claim 1. Second, the Applicants submit that the Office has not properly considered the "associating the delegation token with a document signed electronically" language in claim 1. Furthermore, the Applicants submit that the Office has not properly considered the language "wherein the delegation token is generated

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by a server in response to a request sent by the second signatory in connection with the signing of the document." The Applicants have thoroughly reviewed the cited art of record and submit that these recited features are not disclosed, taught, suggested or contemplated. Accordingly, the Applicants submit that the Office has not established prima facie obviousness of the claims and requests withdrawal of the rejection of claims 1-54.

In the analysis given in the Office Action, it seems that only item 1 above has been considered with respect to the combination of Stringer and Anderson. In an attempt to cure Stringer with regard to item 1 above, the Office cites to Anderson (see page 3 of the Office Action) as disclosing electronically signing documents by means of cryptographic keys. However, the Applicants submit that aspects of the present invention do not relate broadly to signing documents, but rather to signing documents *securely by delegates*. This is suggested neither by Stringer, nor by Anderson.

Even if, for argument's sake, Anderson could cure Stringer with regard to item 1 above, it is submitted that Anderson fails to disclose, teach or suggest any of the above-mentioned items 2, 3, 4 and 5 that are recited in the Applicants' claims but are absent from Stringer's disclosure. Therefore, the Applicants submit that independent claims 1, 18, 26, 37 and 44 are allowable over the combination of Stringer and Anderson. Furthermore, claims depending directly or indirectly from claims 1, 18, 26, 37 and 44 are allowable for at least the foregoing reasons.

Nevertheless, in the event that the Office maintains the rejection of any of the claims, the Applicants respectfully request that the Office either identify where (e.g., in Stringer, Anderson or the other cited art of record) the foregoing-discussed features (e.g., first and second signatories, associating the delegation token with a document signed electronically, wherein the delegation token is generated by a server, etc.) are taught, disclosed or suggested, or apply new art against each feature of each rejected claim, on the record, and with specificity sufficient to support a prima facie case of obviousness according to MPEP 2143.03.

12

In re Appln. of Frisch et al.
Application No. 10/828,729
Response to Office Action of April 26, 2007

The application is considered in good and proper form for allowance, and the Examiner is respectfully requested to pass this application to issue. If, in the opinion of the Examiner, a telephone conference would expedite the prosecution of the subject application, the Examiner is invited to call the undersigned attorney.
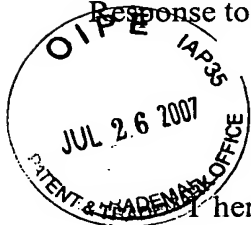
Respectfully submitted,

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Date: July 23, 2007

In re Appln. of Frisch et al.
Application No. 10/828,729
Response to Office Action of April 26, 2007

CERTIFICATE OF MAILING

I hereby certify that this RESPONSE TO OFFICE ACTION OF APRIL 26, 2007 (along with any documents referred to as being attached or enclosed) is being deposited with the United States Postal Service on the date shown below with sufficient postage as first class mail in an envelope addressed to: Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450.

Date: July 23, 2007

Irina L. Mikitiouk

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